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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,044	08/27/2001	Kars-Michiel Hubert Lenssen	NL000525	4488

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

OMETZ, DAVID LOUIS

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,044

Applicant(s)

LENSSEN ET AL.

Examiner

David L. Ometz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10 and 13 is/are rejected.
- 7) ☒ Claim(s) 6-9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/27/01 + 7/16/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election without traverse of Group I in the reply filed on 7/1/094 is acknowledged.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. The information disclosure statements filed 8/27/01 and 7/16/02 have been considered by the examiner. It is noted that the reference "AH" in the 7/16/02 IDS has been lined through as this reference has already been considered by the examiner in the 8/27/01 IDS.
4. The abstract of the disclosure is objected to because "said" should be changed to --the-- in lines 2, 4, and 11. Correction is required. See MPEP § 608.01(b).
5. Claims 11 and 12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should not depend from two previous claims simultaneously. See MPEP § 608.01(n). Accordingly, the claims 11 and 12 have not been further treated on the merits.
6. Claims 3 and 10 are objected to because of the following informalities: in the last line of claim 3, --coupling elements-- should be inserted after "first"; in claim 10, line 6, --the-- should be inserted before "capacitor"; in claim 10, lines 7, --of-- should be inserted before "the base"; in claim 10, line 7, "is" should be changed to --are--. Appropriate correction is required.
7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. Claim 9 sets forth "the conductive material" which lacks antecedent basis, thus rendering the claim vague and indefinite.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/40930. WO'930 shows an information carrier in figures 1, 4 and 5 that includes:

As per claim 1, an information carrier provided with a storage unit (42), an integrated circuit (10), and a first (52) and a second coupling element (54) for the transfer of data and energy between a base station and the integrated circuit (10), which first and second coupling element (52,54) in the operational state are each coupled to both the base station and the integrated circuit (10), and which coupling elements are coupled contactlessly to the base station (inductive coupling 52,54), while the first coupling element is coupled to the integrated circuit (10) by capacitive coupling (19, 66).

As per claim 3, an information carrier characterized in that the first and the second coupling element are coupled to the base station by means of inductive coupling (52,54, fig. 6), for which purpose the first coupling element (52) is at least partly spiraling in shape, and the second coupling element (54) is in electrical contact with the first (see figure 5).

As per claim 4, an information carrier characterized in that the second coupling element (54) is coupled to the integrated circuit (10) by means of capacitive coupling.

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11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 5, 10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO'930 in view of Diezmann et al (US Pat 6044046). WO'930 shows an information carrier provided with a storage unit (42), an integrated circuit (10), and a first (52) and a second coupling element (54) for the transfer of data and energy between a base station and the integrated circuit (10), which first and second coupling element (52,54) in the operational state are each coupled to both the base station and the integrated circuit (10), and which coupling elements are coupled contactlessly to the base station (inductive coupling 52,54), while the first coupling element is coupled to the integrated circuit (10) by capacitive coupling (19, 66). However, WO'930 does not disclose that the coupling elements are capacitively coupled to the base station (claim 2, 10, 13) while also not disclosing the use of the information carrier as an optically readable disk (claim 5). Diezmann et al shows an optically readable disk in figures 1-3 that has an integrated circuit 12 and a coupling element 11 wherein it is disclosed that the transfer of data between the chip and the base station (data processing device) is by capacitive coupling (see claim 12 of Diezmann). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the information carrier of WO'930 an optical disk as taught by Diezmann et al as doing this would permit large quantities of data to be stored reliably in optical form while combining the security features of the integrated circuit built into the disk. In addition, the use of capacitive coupling as taught by Diezmann et al as opposed

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to the inductive coupling taught by WO'930 would have been an obvious replacement as capacitive coupling is well known in the art of disk/IC chip mediums. Therefore, no unobvious result is seen to exist in replacing the inductive coupling to the base station with capacitive coupling as taught by Diezmann et al.

13. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited all show disk storage mediums with integrated circuits disposed therein.

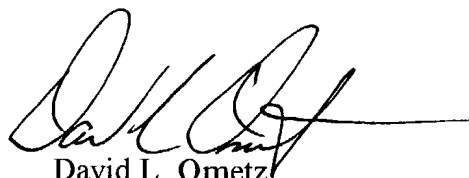
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Ometz whose telephone number is (703) 308-1296.

The examiner can normally be reached on M-W, 6:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David L. Ometz', with a long horizontal flourish extending to the right.

David L. Ometz
Primary Examiner
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DLO
10/18/04